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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,116	02/26/2002	Roy Neff	4159-4005US1	2253
33893	7590	09/22/2006	EXAMINER	
JLB CONSULTING, INC. c/o INTELLEVATE P.O. BOX 52050 MINNEAPOLIS, MN 55402			AGWUMEZIE, CHARLES C	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/086,116	<b>Applicant(s)</b> NEFF ET AL.	
	<b>Examiner</b> Charlie C. Agwumezie	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 136-139 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 136-139 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/4/02; 01/13/03</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Status of claims**

1. Claims 27-135 are previously cancelled. Claims 136-139 are newly added. Claims 1-26 and 136-139 are pending in this application per the response to office action filed on June 30, 2006.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-26 and 136-139 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-26, 136 and 138,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieboer et al U.S. Patent No. 6,418,419 B1 in view of Waelbroeck et al U.S Patent Application Publication No. 2002/0010672 A1.

As per **claims 1, 7, 13 and 14,** Nieboer et al discloses a method operable on a computer for responding to a barter order, the method comprising the steps of:

receiving from a market maker a rule including at least one condition for automatically generating a contra order (col. 2, lines 12-18; col. 3, lines 60-67);

receiving from a trader a barter order request to identify a contra barter order that includes a first security to be sold in a barter and a second security to be purchased in the barter;

matching on the computer the barter order request to the at least one condition comprising the rule (col. 2, lines 12-18); and

automatically responding to the barter order request in accordance with the at least one condition of the rule, if the at least one condition is satisfied, including generating a contra barter order that includes the contra order (col. 2, lines 12-18; col. 19, lines 1-20; see abstract).

What Nieboer does not explicitly teach is generating a contra order.

Waelbroeck et al discloses generating a contra order (0011; see claims 1 and 2)

Nieboer however disclosed that orders are sent and received from the Nasdaq market makers. Nieboer further discloses means for matching orders including if the condition are met, that two or more securities are tradable. Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Nieboer and incorporate the method in which a contra order is automatically generated as taught by Waelbroeck et al in order to create liquidity in the market.

As per **claim 2, 8 and 16**, Nieboer et al further discloses a method wherein:

at least one of the first security or the second security includes a quantity thereof (col. 8, lines 29-54; col. 17, lines 25-67); and

the barter order further including an effective time range (col. 2, lines 1-5; col. 15, lines 50-65).

As per **claim 3, 9, 18 and 23**, Nieboer et al further discloses a method wherein the at least one condition includes at least one variable selected from the group of variables including: the identity of one or more of the first and second securities, the delta between the buy and sell prices of the first and second securities, the relationship of the SIC codes of the first or second securities or any other securities, the market cap of the first or second securities, the average daily volume traded of the first or second securities and the debit value of the bid/ask spread of the first and second securities (col. 1, lines 42-65; col. 9, line 1 – col. 10, line 12).

As per **claim 4 and 10**, Nieboer et al further discloses a method wherein each of the conditions further includes a mathematical operator and a value (col. 15, lines 1-10).

As per **claim 5 and 11**, Nieboer et al further discloses a method wherein:  
the rule further includes at least one pricing tier comprising an offer price range within which a rule is operative and an offer size value up to which a rule is operative (col. 8, lines 27-54); and

if the rule is operative and if the at least one condition of the rule is satisfied, then further comprising the steps of: if the barter offer is a limit order, performing one of the steps of trading the first and second securities (see fig. 8; col. 10, line 11-65), and posting the barter order request for consideration for execution; if the barter order request is a market order, trading the first and second securities; and if a contra barter offer is accepted, trading the first and second securities (see fig. 8; col. 10, lines 11-65).

As per **claim 6 and 12**, Nieboer et al further discloses a method wherein the step of automatically responding includes prompting the operator to provide a manual response (col. 13, lines 1-40).

As per **claims 15, 20, 25 and 26**, Nieboer et al discloses a method operable on a computer for establishing rules to respond to a barter order, the barter order including a first security to be sold in a barter and a second security to be purchased in the barter, the method comprising the steps of:

storing on said computer a plurality of variables and a plurality of operators (col. 2, lines 36-55);

receiving through a graphical user interface input from a market maker selecting from the plurality of variables and operators to form at least one condition (see col. 17, table 1; col. 15, lines 1-45);

responsive to the input, selecting the at least one condition to form a rule for automatically generating a contra order for responding to the barter order and

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automatically generating, if the at least one condition is satisfied, responsive to the barter order, a contra barter including the contra order(see col. 17, table 1; col. 15, lines 1-45; col. 19, lines 1-20).

What Nieboer does not explicitly teach is generating a contra order.

Waelbroeck et al discloses generating a contra order (0011; see claims 1 and 2)

Nieboer however disclosed that orders are sent and received from the Nasdaq market makers. Nieboer further discloses means for matching orders including if the condition are met, that two or more securities are tradable. Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Nieboer and incorporate the method in which a contra order is automatically generated as taught by Waelbroeck et al in order to create liquidity in the market.

As per **claim 17 and 22**, Nieboer et al further discloses a method wherein the input from the user includes selecting at least one variable from the plurality of variables, at least one operator from the plurality of operators and at least one constraint to form the at least one condition (see col. 17, table 1; col. 15, lines 1-45).

As per **claims 19 and 24**, Nieboer et al further discloses a method wherein the rule further includes at least one pricing tier comprising an offer price range within which a rule is operative and an offer size value up to which a rule is operative (col. 11, lines 40-60).

As per **claim 21**, Nieboer et al further discloses a system wherein: at least one of the first security and the second security includes a quantity thereof (col. 8, lines 29-54; col. 17, lines 25-67); and the barter order further including an time date range (col. 2, lines 1-5; col. 15, lines 50-65).

As per **claim 136 and 138**, Nieboer further discloses the method wherein the contra barter order includes the first security and the second security (col. 8, lines 29-54; col. 17, lines 25-67; col. 19, lines 1-20)

4. **Claims 137 and 139** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieboer et al U.S. Patent No. 6,418,419 B1 and Waelbroeck et al U.S Patent Application Publication No. 2002/0010672 A1 as applied to claims 1 or 13, and 7 or 14 above, and further in view of Nordlicht et al U.S. Patent Application No. 2005/0137964 A1.

As per **claims 137 and 139**, both Nieboer and Waelbroeck et al failed to explicitly disclose the method wherein the contra barter order is an implied order including at least a first barter order and one of the group comprising a second barter order and a single-side order.



Nordlicht et al discloses the method wherein the contra barter order is an implied order including at least a first barter order and one of the group comprising a second barter order and a single-side order (0158).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Nieboer and incorporate the method wherein the contra barter order is an implied order including at least a first barter order and one of the group comprising a second barter order and a single-side order as taught by Nordlicht et al in order to respond to users exact orders by generating implied order.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington D.C. 20231**

Or faxed to:

**(571) 273-8300**. [Official communications; including After Final communications labeled "Box AF"].

**(571) 273-8300**. [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"].

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**Charlie Lion Agwumezie**  
**Patent Examiner**  
**Art Unit 3621**  
**September 9, 2006**

*A. Fischer 9/12/06*

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